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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,872	02/21/2002	Walter Callen	09010-108001	9897

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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 05/22/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,872

Applicant(s)

CALLEN ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-120 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-120 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups **1** through **149**, Each group comprises claims 1-29, 47-48, 74-92, 101-106, drawn to Nucleic acid with SEQ ID NO:X, wherein X corresponds to odd number from 1-299, vectors, host cells, probes and a method of making the encoded polypeptide classified in class 435, subclass 69.1.

Groups **150** through **299**, wherein each group comprises claims 30-42, 71-72, 93-94, 107, 111-120, drawn to polypeptides with SEQ ID NO:Y, wherein Y corresponds to the even numbers starting from 1 through 298, and methods of use of the polypeptide classified in class 435, subclass 200.

Groups **300** through **448**, wherein each group comprises claims 43-46, drawn to a purified antibody that specifically binds to a polypeptide with SEQ ID NO:Y, wherein Y corresponds to the even numbers starting from 1 through 298, classified in class 530, subclass 387.1.

Groups **449** through **596**, wherein each group comprises claims 49-62, drawn to a method of producing variant polynucleotide with SEQ ID NO:X, wherein X corresponds to the odd numbers starting from 1 through 299, classified in class 435, subclass 6.

Group **597**, claim 63, drawn to a computer storable medium classified in class 360, subclass 135.

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Group **598**, claims 64-67, drawn to a computer system classified in class 700, subclass 90+.

Group **599**, claims 68-69, drawn to a method of comparing the sequence information using a computer system classified in class 712, subclass 200+.

Group **600**, claim 70, drawn to a method for identification of a feature in a sequence using a computer system classified in class 700, subclass 90+.

Groups **601** through **749**, wherein each group comprises claims 49-62, drawn to an assay for identification of a functional polypeptide or a variant encoded by a polynucleotide with SEQ ID NO:X, wherein X corresponds to the odd number starting from 1-299, classified in class 435, subclass 22.

Groups **750** through **898**, wherein each group comprises claims 95-100, drawn to a method for modifying a small molecule comprising the step of mixing a polypeptide encoded by a polynucleotide with SEQ ID NO:X, to produce at least one small modified molecule, wherein X corresponds to the odd number from 1 through 299, classified in class 514, subclass 789.

Group **899**, claims 108-110, drawn to a liquefied syrup classified in class 536, subclass 102.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1 through 448, 597-598 are all patentably distinct from each other. The polypeptides of groups 150 through 299, the polynucleotides of groups 1-148, the antibodies of groups 300-448, the computer medium and the system of groups 598-599 and the liquefied syrup of group 899 are all different products, each comprising amino acid sequences and nucleotide

sequences, carbohydrates and computer material etc. which are structurally and functionally unrelated, do not require each other for practice; and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions 449 through 596, 599 through 898 are patentably distinct from each other. The method of generating variant polynucleotides of groups 449-596, the method of comparing sequence information of group 599, the method of identifying a feature on a sequence of group 600 and assays for identification of functional variants of groups 601-749 and the method of modifying small molecules of groups 750-898 are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.


MANJUNATH RAO
PATENT EXAMINER

Manjunath N. Rao
May 20, 2003